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09/659,915	09/11/2000	Thomas E. Saulpaugh	5181-63600	5717

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EXAMINER

FISHER, MICHAEL J

ART UNIT PAPER NUMBER

3629

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/659,915

Applicant(s)

SAULPAUGH ET AL.

Examiner

Michael J Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The examiner notes that the information disclosure statements filed 12/22/04, 12/29/04, 1/24/05, 3/11/05 and 3/31/05 include numerous references for which there is no explanation of their relevance and for which there appears to be no relevance. For instance, the non-patent literature reference titled, "Coordinating Distributed Applets with Shade/Java" by Ciancarini et al. would not appear to relate the instant application in any way other than that both use a computer and a data representation language. Further, the non-patent literature reference titled, "Reimplementing Remote Procedural Cells", a master's thesis by Hsu, would also appear to not relate to the instant application in any way other than both appear to relate to the use of computers. Further, the non-patent literature reference titled, "Object Mobility in a Distributed Object-Oriented System" a doctoral thesis by Jul also does not appear to relate to the instant application in any way other than superficially, as they both relate to computers. For instance, in section 1.1.1, on page 4, notes that mobility of processes in a system is useful. As there does not appear to be any mobility of processes in the instant application, or even mention of a distributed environment in any limitation other than the preamble, it is unclear to the examiner how this reference relates to the instant application. Further, the non-patent literature reference titled, "Authentication in Office System Internetworks" by Israel et al. deals mainly with authentication of users. There are currently no claims with limitations referencing authenticating users.

Thus, the many pages of extraneous references could be construed as an attempt to include relevant references with irrelevant references so as to disguise their relevance. As such, the examiner has merely skimmed the supplied references. The process being that the examiner browsed titles and skimmed the references that could possibly apply to the instant application. The examiner would further like to note that the large number of references that are directed toward computer languages such as Eden and Java would not appear to be relevant to the instant application as they are merely the languages used by computers to perform many functions, only a small number of which would relate to the instant application. If the applicant would like a more thorough reading of specific or even all references, the examiner would request a list of references and their associated page numbers that the applicant would like to examiner to more thoroughly inspect.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,237,009. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

As to claims 1,12,24,33,41,46, Waldo discloses a method and apparatus for managing a lease (claim 1), where the client has access to a resource (that which is leased), a client process (the data processing system that manages the lease on behalf of the client, as discussed in claim 1), a client endpoint (the client is shown to able to send messages to and receive them from the network service (as discussed in the abstract)), further sending a lease renewal message (claim 7), it would be inherent that upon leasing a service the client has access to the service.

Waldo does not, however, teach having the system automatically sending the message. It is well settled in case law that to automate a process is well within the skill of one of ordinary skill in the art (in *Re Venner and Bowser* 120 USPQ 192 (CCPA 1598)), therefore, it would have been obvious to one of ordinary skill in the art to automate notifying the customer that the lease will soon expire to ensure that the client is notified in case a person forgets to send the notice.

As to claims 2,13,25, the lease is renewed upon receiving a lease renewal message (claim 9).

As to claims 3,4,26,27,34,35,42,43,47, the lease access is obtained for a first period and upon lease renewal, access is granted for a second period (claim 9), these are accomplished by messages.

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As to claims 5,14, lease periods are negotiable so the lease period could be the same or shorter.

As to claims 6,7,28,29, leases are negotiable so the users could be specified by the customer, whether shared or exclusive.

As to claims 8,9,16,20,21,30,38,48, the lease renewal notice would be an advertisement and would, inherently, contain an address to respond to.

As to claims 10,22,31,39,44,49, it would be inherent that the messages are in a data representation language as they represent data.

As to claims 11,23,32,40,45,51, XML is well known in the art to be used for computer messages and therefore this is not patentably distinct.

As to claim 15, the message specifies the granted lease period (claim 6).

As to claim 17,36, the message endpoint would do so in accordance with a description of the lease renewal message (claim 9).

As to claim 18, the messages would, inherently, be sent to an address where it could be received by the client.

As to claims 19,37, the message is shown to be over a network between computers, the Internet is such a network and therefore, it would have been obvious to one of ordinary skill in the art to use the Internet, and corresponding URL, to send messages so as to not need the customer to be on an expensive, exclusive network as it is well known to connect computers to the Internet.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 5,832,529 to Wollrath et al. (Wollrath).

As to claims 1,12,24,33,41,46, Wollrath discloses a method and apparatus for managing a lease (claim 1), where the client has access to a resource (claim 1), a client process (fig 2), a client endpoint (the client is shown to able to send messages to and receive them from the network service (as discussed in the abstract), further sending a lease acceptance message (claim 11), it would be inherent that upon leasing a service the client has access to the service. The "message endpoint" would be the email system used.

Wollrath does not, however, specifically teach having the system automatically sending the message or using the system to renew a lease. It is well settled in case law that to automate a process is well within the skill of one of ordinary skill in the art (in *Re Venner and Bowser* 120 USPQ 192 (CCPA 1598)), therefore, it would have been obvious to one of ordinary skill in the art to automate notifying the customer that the lease will soon expire (as per claim to ensure that the client is notified in case a person forgets to send the notice.)

Wollrath does teach using the system to track lease lengths (claim 52), and further teaches using the system to renew a lease (claim 9)

It would have been obvious to one of ordinary skill in the art to notify the lessee that the lease is about to expire to ensure that the lessee wants the lease to expire and

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further, Wollrath teaches this a good system to use for leasing and renewing a lease is leasing.

As to claims 2,13,25, the lease is opened upon receiving a lease message (claim 1). It would have been obvious to one of ordinary skill in the art to renew the lease, instead of merely opening a lease, upon receipt of the message so that the lease stays in force.

As to claims 3,4,26,27,34,35,42,43,47, the lease access is obtained for a first period (claim 1) access is granted upon receipt of a message (claim 1), and upon lease the lease expiring, access would be refused (claim 1) and therefore, if the lease is renewed, access would be granted for a second period.

As to claims 5,14, lease periods are negotiable so the lease period could be the same or shorter.

As to claims 6,7,28,29, leases are negotiable so the users could be specified by the customer, whether shared or exclusive.

As to claims 8,9,16,20,21,30,38,48, the lease renewal notice would be an advertisement and would, inherently, contain an address to respond to.

As to claims 10,22,31,39,44,49, it would be inherent that the messages are in a data representation language as they represent data.

As to claims 11,23,32,40,45,51, XML is well known in the art to be used for computer messages and therefore this is not patentably distinct.

As to claim 15, the message specifies the granted lease period (claim 3).

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As to claim 17,36, the message endpoint would do so in accordance with a description of the lease message (claim 9).

As to claim 18, the messages would, inherently, be sent to an address where it could be received by the client.

As to claims 19,37, the message is shown to be over a network between computers (fig 8), the Internet is such a network and therefore, it would have been obvious to one of ordinary skill in the art to use the Internet, and corresponding URL, to send messages so as to not need the customer to be on an expensive, exclusive network as it is well known to connect computers to the Internet.

Response to Arguments

As to arguments in relation to the rejection under double patenting, the message endpoint would be the email program as this is the originator and receiver of email messages for a computing environment. As noted in the above rejection and further in reference to the rejection under double patenting, the client message endpoint would be the email program used to send and receive email. Wollrath discloses leasing, renewing leases is considered to be part of the lease process as leases are routinely renewed. Further, the processes of renewing and originating a lease are similar in their basics, a paper denoting the lease terms must be negotiated and signed by both parties and thus, the reference is deemed proper. As to arguments in relation to whether the prior art could be used in leasing services, the prior art refers to 'leases', which would include the leasing of services. The offer of renewal of a lease would be considered to be an

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advertisement as it is a message for the purpose of eliciting a monetary response from the viewer. Further, the limitation, "data representation language" would be inherent in that computers inherently represent data in languages they can understand.

Specifically, computers understand binary code but are 'programmed' to understand other languages, such as Basic, Fortran or Java. Further, the applicant has provided numerous references that are directed to data representation languages that would appear to point out the obviousness of using these in a computing environment.

The examiner's position is not that XML is well known in leasing art, but that it is well known in the computer art thus making the change obvious.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

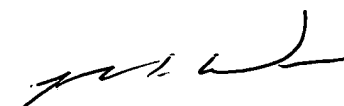
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF

5/24/05



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